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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/722,626 | 11/26/2003 | Keith Yeats | ACO2758US1 | 7113 |

7590

09/08/2005

Lainie E. Parker
Akzo Nobel Inc.
Intellectual Property Department
7 Livingstone Avenue
Dobbs Ferry, NY 10522

EXAMINER

MOORE, MARGARET G

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1712

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

MC

Office Action Summary

Application No.

10/722,626

Applicant(s)

YEATS ET AL.

Examiner

Margaret G. Moore

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11 to 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 to 21 is/are allowed.
- 6) ☒ Claim(s) 22 to 26 and 30 is/are rejected.
- 7) ☒ Claim(s) 27 to 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 22 to 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milligan.

This rejection relies on the same rationale that was detailed in the previous office action. Instant claim 22 corresponds to previous claim 11 with the exception of the upper molecular weight limit of "less than 2000" for the polysiloxane component rather than "about 2000". It is unclear how or why applicants believe that this slight change in wording will render the instant claims unobvious.

As noted in the previous office action, Milligan specifically delineate a lower molecular weight value of 1500, generally 1800. This clearly disclosed lower limit falls well into the newly claimed range of less than 2000. As such this limitation is fully met by Milligan and this fails to overcome the obviousness of the claims.

3. Claims 27 to 29 are objected to as being based upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. This is consistent with the rationale given for claims 16 to 18 in the previous office action.

4. Claims 11 to 21 are allowed. Applicants have amended claim 11 such that the polysiloxane is a branched component. Reading the term branched in view of the definitions of R1 and R2, this polysiloxane now requires the presence of at least one OSi(OR)_3 group as this group is the only possible branching group. Such a polysiloxane is neither taught nor adequately suggested by the teachings in Milligan.

5. The terminal disclaimer filed on 8/18/05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,743,854 has been reviewed and is accepted. The terminal disclaimer has been recorded.

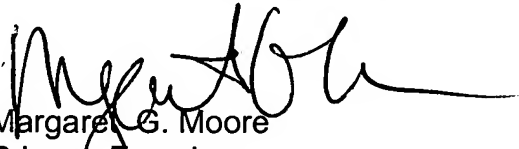
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6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
9/6/05